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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/667,220

09/17/2003

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EXAMINER

SHEWAREGED, BETELHEM

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

06/25/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/667,220	<b>Applicant(s)</b> NARITA ET AL.	
	<b>Examiner</b> Betelhem Shewareged	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Applicant's response along with the Request for Continued Examination (RCE) filed on 06/13/2008 has been fully considered. Claim 1 is amended, claims 2 and 3 are canceled, claims 8 and 9 are added, and claims 1 and 4-9 are pending. NOTE: Since claims 8 and 9 are new, these claims should have been identified as "New".

### ***Claim Objections***

2. Claim 4 is objected to because of the following informalities: Claim 4 recites the limitation "electromagnetic radiation" in line 2; and "material" in line 2. There is insufficient antecedent basis for this limitation in the claim. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Ito et al. (US 4,778,782).

5. Ito teaches a transferable sheet comprising a substrate and a dye receptive layer on the substrate (abstract). In one embodiment, the substrate comprises a core material and a synthetic paper of cellulose fiber paper, a plastic film or a laminate

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thereof provided on a front and a back surface of the core material (Fig. 2 and col. 2, line 31) {the substrate of this embodiment meets the claimed substrate having plurality of sheet. The synthetic paper is white and opaque (col. 3, line 44). A detection mark is provided on the surface of the core material of the substrate (col. 18, line 17).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 4-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ito et al. (US 4,778,782) as applied to claim 1, above, in further view of Oshima (US 6,688,789 B2).

8. Ito does not teach a detection mark that is used in the claimed invention. However, Oshima teaches the use of a detection mark substantially identical to the claimed invention (see at least Sample 13 in Fig. 12 of Oshima), wherein the claimed electromagnetic radiation absorbing value and electromagnetic radiation emitting value would implicitly be achieved. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the detection mark of Oshima with the invention of Ito so as to provide detection mark capable of exhibiting high response (col. 9, lines 57 of Oshima).

9. With respect to claims 6-9, since the criticality of the claimed method of identification and image forming apparatus has not been provided in the current specification, the method of identification and the image forming apparatus are conventional.

### ***Response to Arguments***

10. Applicant's argument is based on that the rejection combining Claim 18 {in Ito there is no claim 18, but it is understood that the Applicants were referring to claim 16} with the embodiment of Fig. 2 is in direct conflict with the express disclosure of Ito; and applicant further argued that, Oshima does not disclose or suggest that any detection mark should be between substrate sheets so that it is unable to be visually perceived and is concealed from human eyes due to the whitish substrate as claimed. These arguments are not persuasive for the following reason(s). Claim 1 teaches the synthetic paper can be laminated on at least one surface of the core. This indicates that the synthetic paper can be laminated on both surfaces of the core, which encompasses the embodiment of Fig. 2. Laminating the synthetic paper on only one surface of the core is not the only option. Furthermore, generally a photoelectric tube detecting device utilizes electromagnetic radiation such as x-ray light, visible light and infrared light; and by using x-ray and infrared, it is clearly possible to detect invisible marks. Since Ito does not expressly limit its invention to detecting only visible marks, it can be interpreted that the detecting device of Ito detects both visible and invisible marks.

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11. The reference of Oshima is used to teach a specific type of detection mark material, not to teach the position of the detection mark. The position of the detection mark is clearly taught by the reference of Ito (see rejection and response to Applicant's argument above).

### ***Conclusion***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betelhem Shewareged whose telephone number is (571)272-1529. The examiner can normally be reached on Monday-Friday 9am-5pm.

13. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BS

June 22, 2008.

/Betelhem Shewareged/  
Primary Examiner, Art Unit 1794.